

REMARKS:

Status Of Claims

Claims 1-12 were previously pending. Claims 1 and 10 has been amended and claims 21-25 have been added. Thus, claims 1-12 and 21-25 are currently pending in the application with claims 1, 21, and 25 being independent.

Office Action

In the office action, the Examiner rejected claims 1-3, 6-8, 10, and 11 under 35 U.S.C. 102(b) as being anticipated by Maguire, U.S. Patent No. 3,881,832. Applicant respectfully asserts that the currently pending claims distinguish the present invention from the prior art made of record.

For example, claim 1 now recites "a frame operable to be set within the watercourse", "a grate seated within the frame and including ... a flange protruding from at least one crossbar", and "a locking element operable to be secured to the flange and contact the frame in order to secure the grate within the frame". The frame is formed or set into a periphery of the watercourse, as shown in the figures and stated on page 4, line 28, though page 5, line 5. Specifically, the "frame can completely circumvent the watercourse 20 or reside on two opposing edges of the watercourse", as stated on page 4, line 29, through page 5, line 1. The grate is a separate element from, but seated within and supported by, the frame. "As the installer turns [a] bolt 36, the locking [element] rises to contact ... the frame 14, thereby securing the grate 12 within the frame 14", as stated on page 7, lines 7-9. Since the frame is "set within the watercourse", securing the grate to the frame also secures the grate to the watercourse. Thus, the frame, the grate, and the locking element are three separate and distinct elements that cooperate to securely cover the watercourse, such that the grate cannot be lifted from the watercourse.

In contrast, as Maguire discloses in column 1, lines 61-65, "a primary object of the invention is to provide a protective insert for sewers to prevent bicycle tires or other

relatively narrow wheels or objects from falling into the longitudinal openings of a conventional sewer grating". Simply put, Maguire discloses a protective insert that fits over a grate. While, Maguire discloses, in column 3, lines 55-58, "attaching members 21 for securely attaching the protective insert 10 to the sewer grating 4", Maguire simply does not disclose securing the grate within a frame, as claimed in claim 1.

The Examiner refers to Maguire's grate (4) as a frame analogous to the frame of the present invention. The Examiner also refers to Maguire's protective insert (10) as a grate analogous to the grate of the present invention. Finally, the Examiner refers to Maguire's wall dividers (6) as a locking element analogous to the locking element of the present invention. Applicant respectfully asserts that these analogies are improper. However, even assuming that these analogies might be proper, they simply cannot anticipate the construction and language of claim 1.

For example, claim 1 claims three separate and distinct elements, a frame, a grate, and a locking element. In contrast, Maguire discloses, in column 2, lines 43-45, "a conventional drop-in sewer grating 4, which has a rectangular perimeter 5 and a plurality of wall dividers 6 between which longitudinal openings 7 are defined". Thus, Maguire's grating (4) includes a frame or perimeter (5) and wall dividers (6), which the Examiner analogizes to the locking element of the present invention, as one element rather than three separate and distinct elements, as claimed in claim 1.

Furthermore, as discussed above, claim 1 claims a locking element operable to be secured to a flange of the grate and contact a frame. Since the locking element is secured to the grate and contacts the frame, it must be separate and distinct with respect to both. In contrast, as discussed above, Maguire's wall dividers (6) are clearly part of the grate (4). Whether Maguire's grate (4) is analogous to the grate or the frame of the present invention is irrelevant, at least in this regard, because the locking element claimed in claim 1 is separate and distinct from both.

Finally, claim 1 recites “a grate seated within the frame”. In contrast, as shown in the figures, Maguire’s protective insert, which the Examiner analogizes to the grate of the present invention, clearly sits atop the grate, which the Examiner analogizes to the frame of the present invention. In fact, as disclosed in column 4, lines 36-50, Maguire’s protective insert (10) preferably presents “a low profile so as to be relatively inconspicuous [and exhibit] minimal interference with snow plows or the like”. Surely such a low profile would be irrelevant if Maguire’s protective insert (10) was capable of being seated within a frame, as claimed in claim 1. Thus, Maguire simply does not disclose “a grate seated within the frame”, as claimed in claim 1. As a result, Maguire cannot anticipate “a frame set within the watercourse”, “a grate seated within the frame and including ... a flange protruding from at least one crossbar”, and “a locking element operable to be secured to the flange and contact the frame in order to secure the grate within the frame”, as claimed in claim 1.

Claim 3 recites “wherein the frame includes shelves for engaging the locking element”. Claim 3 clearly requires the shelves to be part of the frame and engage the locking element. In contrast, the Examiner states “[t]he locking element (6) meets the recitation of shelves”. Applicant disagrees, because the limitation added by claim 3 is directed to the frame, not the locking element. As discussed above, the frame is separate and distinct from the locking element. Thus, Maguire cannot anticipate, “wherein the **frame** includes shelves for engaging the locking element”, emphasis added, as claimed in claim 3.

Claim 10 now recites “wherein the locking element includes a substantially horizontal member operable to receive the bolt and at least one substantially vertical member operable to engage the frame”. Alternatively, claim 11 recites “wherein the locking element is a flat bar”. Thus, claim 10 is clearly directed at a locking element similar to that shown in Figure 2, rather than that shown in Figure 5. Figure 2 clearly shows a horizontal

member (40) for receiving a bolt (36) and vertical members (44) for engaging shelves (32) of the frame (14). It should be apparent that claim 10 is directed at members of the locking element, not of the frame or grating.

In contrast, the Examiner states that Maguire's "locking element includes horizontal (5) and vertical (6) elements. As discussed above, Maguire discloses, in column 2, lines 43-45, "a conventional drop-in sewer grating 4, which has a rectangular perimeter 5 and a plurality of wall dividers 6 between which longitudinal openings 7 are defined". Thus elements referred to by numerals (5) and (6) are part of Maguire's grate, not any locking element. Furthermore, the fact that the Examiner repeatedly refers to Maguire's grate (4) as a frame is irrelevant, since claim 10 is directed at limitations of a locking element and not a frame or a grate. Thus, Maguire simply cannot anticipate "wherein the **locking element** includes a substantially horizontal member operable to engage the bolt and at least one substantially vertical member operable to engage the frame", emphasis added, as claimed in claim 10.

The Examiner also rejected claims 4, 5, 9, and 12 under 35 U.S.C. 103(a) as being unpatentable over Morrison. Applicant respectfully asserts that the currently pending claims distinguish the present invention from the prior art made of record.

For example, claim 5 recites "wherein each crossbar includes a slot along its length of sufficient depth so as to meet each channel and allow the tread bars to be secured to the crossbar by welding a bead along the slot". This interaction between the channels and slots is especially advantageous, since it allows a single bead to be drawn the length of the crossbar and across each tread bar, thereby simplifying construction of the grate.

The Examiner correctly states that Maguire does not disclose the limitations of claims 4 and 5. However, the Examiner asserts that the limitations of claims 4 and 5 would be obvious, without citing a single reference showing these limitations or providing

proper motivation for such a modification of the prior art made of record. Thus, the Examiner has simply not properly supported a *prima facie* case of obviousness.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127

(Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596,1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

In the present case, the Examiner has stated that Maguire does not show the channels and slots as claimed in claims 4 and 5. Thus, the prior art made of record does not 'teach or suggest all of the claim limitations' as required of a *prima facie* case of obviousness. The Examiner goes on to offer a suggestion, not based on prior art made of record, that the channels would be an obvious modification. Specifically, the Examiner stated "it is common to recess a protruding bar structure in order to either create a smoother top surface, or to obtain a more secure positioning of adjacent bars".

However, assuming that the offered motivation can be found in a prior art reference, or 'in the knowledge generally available to one of ordinary skill in the art', the Examiner's suggestion is limited to the functionality of the channels and does not speak to the functionality of the slots. Specifically, as stated on page 6, lines 19-22, the channels (64) accept and support the tread bars (18). The slots (62), on the other hand, are cut into a bottom surface (58) of the crossbars (16) and allow access to a bottom of the tread bars

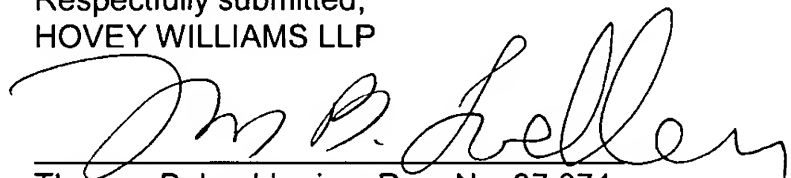
(18), thereby allowing a single bead to be welded along each slot (62) in order to secure all of the tread bars (18) to each cross bar (16). Since the slots (62) are cut into the bottom surface (58), the slots (62) cannot possibly contribute to "a smoother top surface", as suggested by the Examiner. Furthermore, other than improving how the tread bars (18) are welded to the cross bars (16), the slots do not "obtain a more secure positioning of adjacent bars", as suggested by the Examiner. In fact, the tread bars (18) could be welded to the crossbars (16) in a traditional manner, without the slots (62). The slots (62) simply improve how the tread bars (18) are welded to the crossbars (16). Thus, assuming that the Examiner's suggestion is proper with respect to the channels, the Examiner's suggestion cannot be proper with respect to the slots. As a result, since the Examiner has failed to cite prior art references that teach or suggest all of the claim limitations and the Examiner has failed to show a motivation or suggestion to combine such references, these rejections are improper and cannot be sustained.

Claims 21-25 have been added to highlight the features of the present invention discussed above. The remaining claims all depend directly or indirectly from independent claim 1, and are therefore also allowable. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,
HOVEY WILLIAMS LLP

By:



Thomas B. Luebbering, Reg. No. 37,874
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
(816) 474-9050
ATTORNEYS FOR APPLICANT

(Docket No. 32204)